

Remarks

The applicants respectfully submit that this response address each and every issue raised by the Office in the Official Communication. With the granting of the petition for an extension of time, this response has been timely filed. The applicant requests the Office to carefully review these remarks, in conjunction with the amendments to the claims. It is the applicant's position that the claims as currently presented are allowable. This assertion should not be regarded as an admission that the claims as previously submitted were not allowable, but rather, these amendments are being made in the interest of accelerating the allowance of this case. The applicant reserves the right to prosecute the previously submitted claims in a later filing.

The present attorneys for the applicant have inherited this case from another law firm. Please note that we have not received an official copy of the filed application but have had to recreate the claims based on the PCT application. If the claims as presented in this paper do not accurately reflect the state of the claims, the attorneys apologize for the inconvenience and respectfully request the Office to forward a copy of the current state of the claims along with a notice of non-compliant amendment.

Summary of claim amendments: Claim 1 is amended, claim 23 is new, all other claims are resubmitted as originally filed.

Claim Rejections – 35 USC § 103

The Office has rejected claims 1, 5-9 and 11-22 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,721,784 to Leonard et al. and further in view of U.S. Patent No. 6,327,573 to Walker et al. The applicant has amended claim 1 to more explicitly recite a particular aspect of the present invention. However, the arguments presented below in support of the claim as amended, are equally applicable to the former state of claim 1.

Claim 1 recites providing a commercial message to a recipient. The commercial message includes or is associated with tracking software. The tracking software is used to electronically track an aspect of the recipient forwarding the commercial message.

The Office alleges that Leonard discloses the tracking aspect of the present invention. The applicant disagrees. Leonard discloses the use of a central server through which messages can be transmitted and then forwarded. Such a procedure is disruptive to the normal, day-to-day business activities of a consumer or computer user.

The claimed invention utilizes tracking software that is included with, or embedded within, the commercial message. Thus, when the commercial message is forwarded to another recipient, without having to go through a central server, the tracking software reports the forwarding activity. This element is clearly not included in Leonard.

Claim 1 further recites using the tracked aspect as a basis for rewarding the recipient for forwarding the commercial message.

The Office alleges that this aspect of the invention is disclosed in Walker. The applicant respectfully disagrees. Walker discloses a frequent visitor card that can be used by a customer making purchases or visiting a store such as a restaurant. The applicant receives bonus points for purchasing items and for the level of dollars spent. The Office alleges that it would have been obvious to modify Leonard to include this element and thus, alleging disclose or render the claimed invention obvious.

The applicants respectfully submit that the Office has not established a prima facie case of obviousness as required in MPEP § 702.06(j). This assertion is based on the following observations.

(1) There is no suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teachings. Claim 1 recites rewarding a recipient of an email based on the recipient's activity in forwarding that email to others. There is no suggestion in the Walker patent or the Leonard patent regarding a reward for forwarding a message by a recipient. In addition, incorporating a

concept of a frequent visitor card into an email or electronic commercial message environment is simply not plausible and thus, there would have been no motivation to combine these references.

(2) The prior art references do not describe, suggest or teach all of the claim limitations. As stated above, the tracking software aspect of the claimed invention is not disclosed in either reference. Further, the inventive aspect of awarding points based on forwarding of a message to another recipient is not described suggested or taught in either reference.

Thus, the applicants reiterate that the cited references do not meet the prima facie case for obviousness and as such, are an invalid basis for an obviousness rejection of claim 1. Therefore, the applicant respectfully submits that claim 1 is allowable and kindly requests the Office to agree.

Claims 2-22 each depend either directly, or indirectly from claim 1 and thus, are also in condition for allowance.

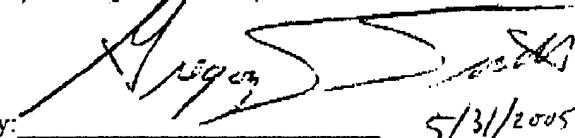
Claim 23 is a new claim and is allowable for the same reasons set forth with regards to claim 1.

Conclusion

Applicant respectfully submits that the currently pending claims are in condition for allowance and respectfully requests that the case be processed to issuance. One new independent claim has been added. As it stands, the application includes 2 independent claims and 23 claims in total. The fee for an additional claim is being submitted herewith.

If the Office has any questions or if there are any actions that can be handled through an Examiner's Amendment, the applicant requests the Office to contact the attorney of record using the below-provided contact information.

Respectfully submitted,

By:  5/31/2005

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